REMARKS

This amendment and reply is in response to the Office Action dated April 17, 2009. Claims 1-11 and 19-43 are pending. Of these, claims 19-33 and 43 are withdrawn. Claims 1, 4, 5, and 6 have been amended. Claim 3 has been cancelled. No new matter is added. In view of the claim amendments and the following remarks, Applicants believe the claims are in condition for allowance, which action is requested.

Claim Rejections Under § 102(b)

Claims 1, 7 and 9 are rejected under 35 U.S.C. 102(b)as anticipated by U.S. Patent No. 5,817,017 (Young). Claim 1, as amended, recites a metallic support structure formed such that magnetic field changes in a region immediately proximate the support structure, induced by a magnetic resonance imaging process, are substantially unobstructed and a magnetic material at least embedded into at least part of the support structure. The Young reference, however, dose not disclose that the magnetic material is embedded into at least a part of the metallic support structure.

Young discloses a non-metallic tubular member such as a catheter having paramagnetic ionic particles incorporated into the non-metallic material. Indeed, the paramagnetic materials and the non-metallic material form the structure of the tubular member. "[I]t has been found that suitable paramagnetic ionic particles can be combined with suitable polymeric materials and extruded into a desired shape, such as a flexible tube...." (Young, col. 3, lines 5-10). Moreover, Young further discloses that the paramagnetic ionic particles will be "dispersed directly within the material matrix of the non-metallic member" and may be accomplished by "conventional techniques, such as impregnation, lamination, coating, compounding or the like." (Young, col. 9, lines 50-59). Moreover, Young further teaches that with organic polymers, the paramagnetic material and polymer should preferably be combined before extrusion (e.g., before formation of the catheter structure).

As such, Young does not disclose the metallic support structure having embedded magnetic material as claimed. Claims 7 and 9 are dependent on claim 1, as amended, and should be allowable for at least the same reasons. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claim rejections under 35 U.S.C. § 103

Claim 8 is rejected under 35 U.S.C. § 35 U.S.C. § 103 as being unpatentable over Young. Claim 8 depends from claim 1, as amended, and is directed to a metallic support structure formed such that magnetic field changes in a region immediately proximate the support structure, induced by a magnetic resonance imaging process, are substantially unobstructed and a magnetic material at least embedded into at least part of the support structure, wherein the magnetic material is ferromagnetic.

As mentioned above, Young teaches a non-metallic tubular member such as a catheter having magnetic ionic particles incorporated into the non-metallic material. Indeed, the magnetic materials and the non-metallic material form the structure of the tubular member. The magnetic particles in Young are preferably, "dispersed directly within the material matrix of the non-metallic member" and may be accomplished by "conventional techniques, such as impregnation, lamination, coating, compounding or the like." (Young, col. 9, lines 50-59). Young teaches that with organic polymers, the paramagnetic material and polymer should preferably be combined before extrusion. There is nothing in Young, however, to give a skilled person reason to modify the technique for incorporating a magnetic particle into a polymeric material and to further apply the modified technique to a metal structure. The mere fact that the prior-art reference could be modified does not satisfy the requirements for a finding of obviousness. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 2-6, 10, 11 and 34-40 are rejected under 35 U.S.C. § 103 as being unpatentable over Young in view of U.S. Patent No. 7,156,869 (Pacetti '869). The Examiner states that Young does not disclose a metallic stent. (4/14/2009 Office Action at p. 4). The Examiner argues that Pacetti '869 teaches that metallic stents are well known in the art and that applying the technique of Young to a metallic stent, such as Pacetti '869 would result in the claimed invention.

As discussed above, Young discloses a tubular catheter of polymeric material having magnetic material incorporated into the matrix of the polymeric material, preferably before extrusion, so that the polymeric material and the magnetic particles form the structure of the tubular member. One of skill in the art would have no reason to apply a technique directed to polymeric materials to a metallic stent.

Pacetti '869 does not cure this defect. Nowhere in Pacetti '869 is there a discussion or teaching to increase visibility by applying magnetic particles to the stent. Moreover, applying the teaching of Young — directed to combining magnetic particles with a polymeric material — to that of Pacetti '869, does not produce a metallic stent having magnetic particles embedded in at least a portion of the metallic support structure, as claimed. Pacetti '869 is directed to a drug-eluting stent system for the treatment of edge restenosis in a blood vessel. Citing the entire document, the Examiner argues that Pacetti '869 discloses metallic stents generally and "suggests that metallic and biodegradable materials are well known in the art for forming such devices." (4/14/2009 Office Action at p. 4). But the Examiner gives no support for how the Pacetti '869 teaches one of skill in the art to embed magnetic particles in a metallic support structure.

As the Supreme Court recently explained, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 (U.S. 2007). In that regard, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* The mere fact that the

prior-art reference could be modified does not satisfy the requirements for a finding of obviousness. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). There is no reason to modify the stent disclosed in Young or Pacetti to obtain the claimed subject matter. And reliance on what is presumed to be the level of skill in the art is improper in the absence of a specific teaching because skill in the art cannot "act as a bridge over gaps in the substantive presentation of an obviousness case." *Al-Site Corp. v. VSI Int'l, Inc.*, 174, F.3d 1308, 1324 (Fed. Cir. 1999). Furthermore, deficiencies in the cited reference cannot be remedied by general conclusions about what is basic knowledge. *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002).

Here, the Examiner has improperly combined Young with Pacetti '869 as there is no reason one of skill in the art would combine the teaching of Young with the general knowledge that stents can be made of metal, Pacetti '869, to produce the claimed subject matter. Moreover, if the two references were properly combined, Young in combination with Pacetti does not produce the claimed subject matter. And it is improper to overcome these deficiencies with general conclusions about basic knowledge in the art. Applicants respectfully request reconsideration and withdrawal of the claim rejections.

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,712,844 (Pacetti '844) in view of Young. Claim 41 recites a stent comprising a tubular structure comprising a plurality of rings comprising electrically conductive material, wherein each ring forms a serpentine path around the tubular structure; connector comprising electrically conductive material, extending between and connecting adjacent rings to one another; an electrical discontinuity, comprising insulating material, provided in each ring to prevent an electrically conductive loop from forming, and magnetic material embedded into the tubular structure only at end portion of the tubular structure.

The Examiner states that Pacetti '844 fails to disclose magnetic material embedded into the end portions of the support structure. Pacetti '844 is directed to a metallic stent having discontinuities having non-conductive material to prevent the formation of electrical paths during MRI. Nowhere in Pacetti '844 is there a disclosure, teaching or reason to embed magnetic

particles in the metallic, electrically conductive support structure. And as discussed above, Young is directed to combining magnetic particles into the matrix of a polymeric catheter, preferably before extrusion. Young does not disclose embedding magnetic particles in an electrically conductive support structure. Moreover, one of skill in the art would have no reason to combine Young and Pacetti '844 to obtain the claimed subject matter. Nor does the teaching of Young, combined with the stent of Pacetti '844 produce the claimed subject matter. As such, Applicants respectfully request reconsideration and withdrawal of the claims.

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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